REMARKS

Applicant is filing this Amendment and Response in response to an Official Action dated September 13, 2006. At the time of the Official Action, claims 1-34 were pending. In this Response and Amendment, claims 1, 2, 4, 10, 13, 19-22 and 26-33, are amended and claims 11 and 34 are cancelled. No new claims are added. Accordingly, claims 1-10 and 12-33 remain currently pending.

Objection to the drawings

In the Office Action, the Examiner objected to the drawings as including a reference character not mentioned in the specification. Applicant submits that reference numeral 208 is adequately shown and described in FIG. 4. Nonetheless, Applicant has amended the specification to include reference numeral 208 of Fig. 4 in the written description for the purpose of advancing prosecution of the case. *See*, Application, paragraph 29, as amended.

Summary of the Rejections

In the Office Action, claims 1, 2, 5-7, 19, 23-27, 29-31 and 34 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,088,033 to Binkley et al. ("the Binkley reference"). Claims 3, 8, 9, 21, 32 and 33 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley in view of Van Ee et al., U.S. Patent No. 6,937,972 to Van Ee et al. ("the Van Ee reference"). Claims 4, 22 and 28 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley as applied to claims 1, 19 and 16 above, in view of Burg et al., U.S. Patent No. 6,456,699 to Burg et al. ("the Burg reference"). Claims 10-12, and 14-17 were rejected under 35 U.S.C. § 103(a) as being obvious based on Binkley in view of Stockburger et al., ("Virtual Onside Support: Using Internet Chat and Remote Control to Improve Customer Service," Proceedings of the 30th Annual ACM SIGUCCS Conference on

User Services, Providence, Rhode Island, pages: 143-147, 2002), ("the Stockburger reference"). Claim 13 was rejected under 35 U.S.C. 103(a) as being obvious over Binkley as modified by Stockburger as applied to claim 10 above, and further in view of Berg et al. Claim 18 was rejected under 35 U.S.C. 103(a) as being obvious over Binkley in view of Stockburger as applied to claim 10 above, and further in view of Van Eu. Each of these rejections is addressed in detail below.

The Rejection Under 35 U.S.C. § 102(b)

With respect to the rejection of independent claims 1, 19 and 26 under Section 102 based on Binkley, the Examiner stated:

> 4. Claims 1,2, 5-7, 19, 20, 23-27, 29-31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Binkley et al (US Patent 5,088,033).

> 5. As to Claims 1, 19, 26 and 34, Binkley et al teaches: a system, comprising: at least one device information file that contains emulation information about at least one device (column 28, lines 35-50; column 31, lines 1-8); and an emulator that is adapted to read the at least one device information file and provide an on-screen display ("OSD") emulation of the at least one device (column 7, lines 13-16; column 7, lines 39-43.

Office Action, p. 3.

Legal Precedent

The Applicant respectfully traverses the rejection. Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In order to maintain a proper rejection under section 102, a single reference must teach each

and every element or step of the rejected claim, else the reference falls under section 103. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention *"in as complete detail as contained in the ... claim"* to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

In the present case, the Binkley reference does not anticipate the Applicant's claims under Section 102 because every element of the claimed invention is not identically shown in the Binkley reference. Specifically, independent claim 1 recites a computer system having a plurality of device information files and "an emulator that is adapted to read a *selected* one of *the plurality of device information files* and provide an on-screen display ("OSD") emulation of the at least one device corresponding to the selected one of the plurality of device information files." (Emphasis added.) Similarly, independent claim 19 recites a system having a plurality of device information files that contain emulation information about at least one device, and means for "providing an on-screen display ("OSD") emulation of *the at least one device whose emulation information is contained in a selected one of the plurality of device information files."* (Emphasis added.) Further, independent claim 26 recites a tangible machine-readable medium having a plurality of device information files and a machine-readable code comprising an emulator program "adapted to read a *selected one of the plurality of device information files* and provide *an on-screen display ("OSD")* emulation of a set-up procedure. (Emphasis added.) Claim 26 further recites the set up procedure is associated with "the at least one device whose *emulation information is contained in the selected one of the plurality of device information files."* (Emphasis added.) Hence, the present claims are directed towards an on-screen display (OSD) emulation employed by

remote employees, such as call center operators and the like, to reproduce a visual display or other feedback that a customer sees or otherwise receives when the customer is trying to set up a newly purchased device, such as a computer system or computer monitor.

In contrast to the Applicant's claims, the Binkley reference discloses a system which is modified to include an additional processor configured to execute software otherwise poorly or not executable at all by the original unmodified system. Particularly, the Binkley reference discloses:

> The present invention combines a host system with an emulating processor which is capable of running software written for a target system. The emulating processor is added so as not to prevent the host system CPU from performing its own independent operations...

Binkley, col. 1, lines 60- 64.

Binkley further discloses:

> The emulating processor is thus added in a manner which protects the host system CPU from crashes in the target system software, since the host system CPU is not executing the software which leads to the crash and may continue with its independent operation.

Binkley, col. 2, lines 5-9.

Hence, emulation, as disclosed in Binkley, requires an added processor to augment a system's performance in executing particular software. Binkley does not teach, suggest or illustrate a system in which a particular on-screen display (OSD) emulation is selected from among a plurality of possible choices. Thus, Binkley does not disclose a system having a plurality of on-screen display (OSD) choices to be utilized by remote employees, such as call center operators and the like, to reproduce a visual display or other feedback that a customer sees or otherwise receives when the customer is trying to set up a newly purchased device, such as a

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computer system or computer monitor. Indeed, the Binkley reference does not disclose or suggest a computer system having a plurality of device information files, much less a plurality of device information files used with an emulator adapted to read a selected one of the plurality of device information files and provide an on-screen display emulation of at least one device corresponding to a selected one of the plurality of device information files, as recited by independent claim 1. Neither does Binkley disclose providing an on-screen display emulation of at least one device whose emulation information is contained in a selected one of a plurality of device information files, as recited by independent claim 19. Moreover, Binkley does not disclose a tangible machine readable medium having a plurality of device information files and machine-readable code comprising an emulator program adapted to read a selected one of the plurality of device information files and provide an on-screen display emulation or a set-up procedure, as recited by independent claim 26.

For at least these reasons, the Applicant respectfully submits that independent claims 1, 19 and 26 (and the claims dependent thereon) are not anticipated by the Binkley reference. Accordingly, the Applicant respectfully requests the withdrawal of the rejection of claims 1, 2, 5-7, 19, 20, 23-27, 29-31 and 34 under Section 102 based on Binkley.

Dependent Claims 2, 20 and 27

In the Office Action, the Examiner rejected dependent claims 2, 20 and 27 as being anticipated by the Binkley reference. Applicant notes that aside from being dependent upon an allowable base claim, the rejection of dependent claims 2, 20 and 27 is improper because their subject matter is clearly not disclosed in Binkley. Particularly, claims 2, 20 and 27 recite "wherein the emulation information comprises information relating to a set-up procedure of the at least one device." The portion of text set forth by Binkley which the

Examiner interpreted as the above claim recitation teaches configurations and set-up

procedures executed by an augmented computer system having an additional processor for

emulating memory registers and mapping thereof, as well as floppy disk drives and so forth.

See, Binkley, col. 28 lines 35-50; col. 31, lines 1-8. Consequently, Binkley's disclosure fails

to teach or suggest an emulator that provides an on-screen display corresponding to a selected

one of a plurality of device information files such that the emulation information comprises

information relating to a set-up procedure of the device, as recited by dependent claims 2, 20

and 27. Absent any such disclosures, the rejection of claims 2, 20 and 27 under Section 102

must be withdrawn.

The Rejection Under 35 U.S.C. § 103

With respect to the rejection of claims 10-12 and 14-17 under 35 U.S.C. § 103 as

being rendered obvious by Binkley in view of Stockburger, the Examiner stated:

> 23. Claims 10-12, 14-17 are rejected under 35 U.S.C.
> 103(a) as being unpatentable over Binkley et al in view of
> Stockburger et al ("Virtual Onsite Support: Using Internet Chat
> and Remote Control to Improve Customer Service",
> Proceedings of the 30th Annual ACM SlGUCCS Conference
> on User Services, Providence, Rhode Island, pages: 143 -
> 147,2002).
>
> 24. Binkley et al teaches: (claim 10) identifying a
> device information file that comprises emulation information
> about a set-up procedure associated with at least one device
> (column 28, lines 35-50; column 31, lines 1-8); (claim 10)
> invoking an emulator that is adapted to access the device
> information file and provide an emulation that is based on the
> emulation information (column 7, lines 13-16; column 7, lines
> 39-43; column 30, line 58-column 31, line 15); (claim 11)
> providing an on-screen display ("OSD") emulation based on the
> emulation information (column 7, lines 13-16; column 7, lines
> 39-43); (claim 12) defining the emulation to be presented in a
> manner that approximates an output provided by the at least
> one device (column 7, lines 39-56); (claim 14) defining the at
> least one device to comprise a computer display device (Figure
> 2, element 22b; column 7, lines 39-43); (claim 15) defining the
> at least one device to comprise a computer system (Figure 2,

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element 22); (claim 16) defining the at least one device to comprise a consumer electronics device (Figure 2, elements 22, 22a, 22b, 22c, 24, 26, 28).

25. Binkley et al does not expressly teach: (claim 10) providing instruction to a user based on the emulation; (claim 17) accessing the emulator via a network.

26. Stockburger et al teaches the use of a remote control utility that is a useful tool for the staff of a Help Desk, enabling the staff to get problems fixed in a matter of minutes instead of hours, and allowing the customer to learn something in the process, therefore, contributing to an improved image of the Help Desk and the IT Department of a facility (Conclusion, paragraph 1, lines 3-8). Stockburger et al teaches that the customer can share their screen, or give complete control of their screen to the help desk technician (Abstract, last paragraph, lines 6-9), which sets up an emulation of the customer's computer on the technician's computer via a network (Abstract, last paragraph, lines 5-9; page 145, paragraph 3; see figure on page 146, and description, page 145, paragraph 2) and allows the technician to provide instruction to a user based on the emulation (page 146-147, last bullet).

27. Binkley et al and Stockburger et al are analogous art since they are both directed to the emulation of an electronic device and providing an on-screen display of the emulated device.

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device emulation and on-screen display of the emulated device as taught by Binkley et al to include providing instruction to a user based on the emulation as taught by Stockburger et al since Stockburger et al teaches the use of a remote control utility that is a useful tool for the staff of a Help Desk, enabling the staff to get problems fixed in a matter of minutes instead of hours, and allowing the customer to learn something in the process, therefore, contributing to an improved image of the Help Desk and the IT Department of a facility (Conclusion, paragraph 1, lines 3-8).

Office Action, pp.7-9.

Legal Precedent

The Applicant respectfully traverses the rejection. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The rejection of independent claim 10 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of independent claims 1, 19 and 26 under Section 102. Moreover, neither Binkley nor the supporting reference Stockburger discloses a method comprising identifying a plurality of device information files that each contains emulation information about a set-up procedure associated with at least one device. Further, neither Binkley nor Stockburger disclose invoking an emulator that is adapted to access the plurality of device information files and provide an on-screen display ("OSD") emulation that is based on the emulation information for the at least one device contained in a selected one of the plurality of device information files, as recited by independent claim 10. Binkley and Stockburger also fail to disclose providing instruction to a user based on the OSD emulation, as further recited by independent claim 10.

Accordingly, the combination of the Binkley and the Stockburger references cannot render the Applicant's claims obvious. The Applicant therefore respectfully asserts that the rejection of independent claim 10 and claims dependent therefrom under Section 103 is erroneous and should be withdrawn.

Rejection of Dependent Claims Under Section 103

The Examiner rejected dependent claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33 under 35 U.S.C. § 103(a) as obvious over the Binkley reference in view of other secondary references. Applicant respectfully traverses these rejections. Applicant respectfully submits that claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33 are allowable based on their dependencies from independent claims 1, 10, 19 and 26 because the secondary references do not cure the deficiencies described above in regard to the Binkley reference. For at least these reasons, Applicant respectfully asserts that the Examiner has clearly not established a *prima facie* case
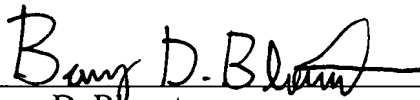
of obviousness with regard to claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33. Accordingly, Applicants respectfully request that the Board overturn the rejection and allow claims 3, 4, 8, 9, 11-18, 21, 22, 28, 32 and 33.

Conclusion

In view of the remarks set forth above, the Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims 1-10 and 12-33. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: <u>December 13, 2006</u>

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